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| 10/682,122 | 10/10/2003 | Koji Kinoshita | 243872US2 | 8225 |

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| EXAMINER | |
|---|---|
| SHIN, KYUNG H | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2443 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|---|---|---|---|
| ***Office Action Summary*** | **Application No.**<br>10/682,122 | **Applicant(s)**<br>KINOSHITA ET AL. | |
| | **Examiner**<br>Kyung Hye Shin | **Art Unit**<br>2443 | |

***-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *RCE 11-11-08*.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,3-7 and 11* is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1,3-7 and 11* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☒ All b)☐ Some * c)☐ None of:
    1.☒ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-11-2008 has been entered.

2. Claims **1, 3 - 7, 11** are pending. Claims **1, 11** have been amended. Claims **2, 8 - 10, 12 - 18** have been cancelled. Claims 1, 11 are independent. This application was filed on 10-10-2003 and foreign priority date on 10-15-2002.

### *Response to Arguments*

3. Applicant's arguments have been fully considered and they are moot and new grounds of rejection have been entered.

### *Claim Rejections - 35 USC § 103*

**The text of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

4. Claims **1, 3 - 7, 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cocotis et al.** (US PGPUB No. **20030078965**) in view of **Miller et al.** (US PGPUB

No. **20020023959**) and further in view of **Parry** (US Patent No. **7,075,668**) and further in view of **Shea** (US Patent No. **7,123,376**) and **Wong et al.** (US Patent No. **6,580,490**).

**Regarding Claim 1**, Cocotis discloses a printing management system comprising a printing management server which is connectable to a user terminal via a network and a printing apparatus which is connectable to a document server via a network,

wherein the printing management server includes:

receiving unit, which receives a printing request of an electronic file, via the network;

(Cocotis para 005, ll 1-4: system for managing print (print management); para 073, ll 1-6: document server; para 124, ll 1-2; para 112, ll 1-2; para 121, ll 1-4: receive printing request)

a sending unit, which sends back the identification information to the user terminal, via the network. (Cocotis para 206, ll 7-12: send back identification information for printing)

the printing apparatus includes:

a printing unit, which prints the obtained electronic file based on the extracted information concerning the printing condition. (Cocotis para 098, ll 4-8: printing or output devices)

Cocotis discloses wherein an identification information generating unit, which generates identification information, including information concerning a storing place of the electronic file based on the received printing request of the electronic file. (Cocotis para 154, ll 8-10; para 158, ll 1-9: storage for file) And, Cocotis discloses wherein an electronic file obtaining unit, which obtains an electronic file from the electronic file management server, via the network, based on the read identification information; (Cocotis para 158, ll 1-9: printing information (electronic file) obtained) In addition, Cocotis discloses the generation of identification information including the storing place of the electronic file. (Cocotis para 158, ll 1-9: identification information) Cocotis does not explicitly disclose whereby an identification pattern generating unit, which generates identification patterns, including additional information associated with pattern and a reading unit, and information concerning a printing condition.

However, Miller discloses wherein an identification pattern generating unit, which generates identification patterns. (Miller para 045, ll 1-9; para 055, ll 1-6: document processing, barcode representation linked to identification information)

a reading unit, which reads identification pattern output by a user terminal; (Miller para 045, ll 1-9; para 055, ll 1-6: document processing, barcode representation linked to information; para 043, ll 3-9: barcode reader)

extracts information concerning the electronic file from the identification pattern; (Miller para 045, ll 1-9; para 055, ll 1-6: document processing, barcode representation linked to information)

It would have been obvious to one of ordinary skill in the art to modify Cocotis for a reading unit as taught by Miller. One of ordinary skill in the art would have been motivated to employ the teachings of Miller in order to access a wealth of information concerning an entity from a single piece of information, the barcode.

(Miller para 006, ll 1-5: *" … Although a bar code may uniquely identify an item (or set of items) that are of interest to a person, he or she generally has no way to access information concerning the item from the bar code itself. … "; para 006, ll 9-13: " … In particular, the ever-growing use of computers and other electronic devices and communication routes between such devices (e.g., the Internet) means that an abundance of information is available to consumers, … "; para 007, ll 11-15: " … Further, there is a need for a system and methods for gathering and using information about consumers who use the items. To meet these needs, a system capable of receiving bar codes or bar code representations, storing them and relevant information concerning items corresponding to the bar codes, and displaying such information upon demand is also required. … "*)

And, Parry discloses:

information concerning a printing condition; (Parry col 1, ll 62-67: translated barcode includes information on printing the document (printing condition); col 2, ll 3-7: translation comprises translating the barcode to obtain at least one identifier that designates the type of contents in the document)

It would have been obvious to one of ordinary skill in the art to modify Cocotis-Miller for information concerning a printing condition as taught by Parry. One of ordinary skill in the art would have been motivated to employ the teachings of Parry in order to enable an error free transmission of a document to a printer or other device such as a fax machine or copier simply by sending an email with one or more barcodes embedded therein. (Parry col 7, ll 29-32: *" … Accordingly, an error free* *transmission of a document to a printer or other device such as a fax machine or copier, can be accomplished simply by sending an email with one or more barcodes embedded therein. … "*)

Cocotis does not explicitly disclose a printing condition unit including *at least one of* a sheet size, a printing quantity, a black and white/color printing selection, a reduction ratio and a quantity of pages N,
the quantity of pages N corresponding to the number of pages to be placed on a single page in N-up printing.

However, Shea discloses:

a printing condition unit (Shea col 4, ll 39-42: printstream is sent from printstream processor to a printer; col 2, l 65 - col 5, l 2: sent to message router for delivery to specified delivery mechanism, e.g. a printer; col 6, ll 52-58: document data may include information identifying data fields and instruction to a printer) including a quantity of pages N; (Shea col 7, ll 24-30: bar code may include page total indicating how many pages; col 7, ll 58-67: parser may consult a total page count as stored in a barcode code; barcode indicates that a currently document contains "n" documents)

It would have been obvious to one of ordinary skill in the art to modify Cocotis-Miller-Parry to enable a printing condition unit including a quantity of pages N as taught by Shea. One of ordinary skill in the art would have been motivated to employ the teachings of Shea in order to utilize bar code data within an electronic printstream to assist in identifying and formatting printstream data for electronic presentment such as printing. (Shea col 1, ll 9-12: " ... *More particularly, the present invention utilizes bar code data within the electronic printstream to assist in identifying and formatting printstream data for electronic presentment.* ... ")

And, Wong discloses specific printing conditions wherein:

a black and white/color printing selection, and a reduction ratio. (Wong col 3, ll 41-47: optics for such a printer must provide telecentric illumination for color printing applications employing LCD modulators; col 12, ll 2-6: alternative embodiment of printer; dithering pattern for a LCD modulator is shown; col 4, ll 53-58: using different reduction ratios; arrangements at lower reduction ratios; arrangements at higher reduction ratios; commonly agreed upon by COM (printing systems) equipment and manufacturers; col 16, ll 60-66: barcode or other optical encoding; barcode reader)

It would have been obvious to one of ordinary skill in the art to modify Cocotis-Miller-Parry-Shea for a black and white/color printing selection or a reduction ratio as taught by Wong. One of ordinary skill in the art would have been motivated to employ the teachings of Wong in order for an improved printing apparatus that is inexpensive, compact, and robust, and that allows printing in any of a plurality of output media formats. (Wong col 6, ll 1-5: " ... *Thus, it can be seen that there is a need for an improved COM printing apparatus that is inexpensive, compact, and robust, and that allows printing in any of a plurality of output media formats, including printing of multiple images at one time, with potential throughput benefits.* ... ")

**Regarding Claims 3**, Cocotis discloses the printing management system according to claims 1. (Cocotis para 005, ll 1-14: printing system for local or remote systems) Cocotis does not explicitly disclose whereby the identification pattern is a barcode. However, Miller discloses wherein the identification pattern is a barcode. (Miller para 045, ll 1-9; para 055, ll 1-6: document processing, barcode representation linked to information)

It would have been obvious to one of ordinary skill in the art to modify Cocotis where the identification pattern is a barcode as taught by Miller. One of ordinary skill in the art would have been motivated to employ the teachings of Miller in order to access a wealth of information concerning an entity from a single piece of information, the barcode. (Miller para 006, ll 1-5; para 006, ll 9-13; para 007, ll 11-15)

**Regarding Claims 4**, Cocotis discloses the printing management system according to claims 1, wherein the receiving unit receives the printing request, by electronic mail, and the sending unit sends back an electronic mail. (Cocotis para 005, ll 1-14: printing system for local or remote systems; para 121, ll 1-4; para 098, ll 4-8: e-mail request/response capability) Cocotis does not explicitly disclose whereby including information concerning the identification pattern. However, Miller discloses wherein including information concerning the identification pattern. (Miller para 045, ll 1-9; para 055, ll 1-6: document processing, barcode representation linked to information)

It would have been obvious to one of ordinary skill in the art to modify Cocotis to include information concerning the identification pattern as taught by Miller. One of ordinary skill in the art would have been motivated to employ the teachings of Miller in order to access a wealth of information concerning an entity from a single piece of information, the barcode. (Miller para 006, ll 1-5; para 006, ll 9-13; para 007, ll 11-15)

**Regarding Claims 5**, Cocotis discloses the printing management system recording medium according to claim 1 that further comprises an electronic file generating unit, which generates the electronic file based on the printing request, and stores the electronic file in a predetermined storing area. (Cocotis para 005, ll 1-14: printing system for local or remote systems; para 124, ll 1-2; para 112, ll 1-2; para 121, ll 1-4: request for file printing; para 244, ll 9-11: file storage)

**Regarding Claims 6**, Cocotis discloses the printing management system recording medium according to claim 1, wherein the information concerning the storing place of the electronic file, is information concerning URL. (Cocotis para 005, ll 1-14: printing system for local or remote systems; para 300, ll 6-10; para 308, ll 1-4; para 202, ll 6-11: URL indicator for file location)

**Regarding Claim 7**, Cocotis discloses the printing management system according to claim 1, wherein the network, includes Internet. (Cocotis para 005, ll 1-14: printing system for local or remote systems; para 073, ll 1-6; para 077, ll 7-10: Internet communications)

**Regarding Claim 11**, Cocotis discloses an electronic file printing method that performs printing of an electronic file of a document, applying a user terminal, a printing apparatus, and an electronic file management server, connected via a network, comprising:

a receiving step, wherein the electronic file management server receives a printing request of an electronic file, sent by the user terminal, via the network; (Cocotis para 112, ll 1-2; para 121, ll 1-4: receive printing request; para 042, ll 9-11: network connections)

a displaying step, wherein the user terminal displays the received identification pattern; (Cocotis para 300, ll 6-14; para 308, ll 1-4: user interface display)

a printing step, wherein the printing apparatus performs printing of the obtained electronic file based on the extracted information concerning the printing information. (Cocotis para 098, ll 4-8; para 300, ll 14-17: printing of file)

Cocotis discloses wherein a sending back step, wherein the electronic file management server generates an identification pattern, including information concerning a storing place of the electronic file based on the received printing request of the electronic file, and sends back the identification pattern to the user terminal. (Cocotis para 206, ll 7-12: send back identification information for printing) And, Cocotis discloses wherein an obtaining step, wherein the printing apparatus obtains the electronic file, from the electronic file management server, via the network, based on the obtained identification information; (Cocotis para 206, ll 1-15: retrieve file from storage; para 042, ll 9-11: network connections) Cocotis does not explicitly disclose whereby identification information within an information pattern, and information concerning a printing condition.

However, Miller discloses wherein identification information within an identification pattern. (Miller para 045, ll 1-9; para 055, ll 1-6: document processing, barcode representation (identification pattern) linked to additional information)

an obtaining step, wherein the printing apparatus obtains the identification pattern from a reading apparatus that reads the identification pattern, displayed by the user terminal; (Miller para 045, ll 1-9; para 055, ll 1-6: document processing, barcode representation linked to information; para 043, ll 3-9:barcode reader)

extracts information concerning the electronic file from the identification; (Miller para 045, ll 1-9; para 055, ll 1-6: document processing, barcode representation linked to information)

It would have been obvious to one of ordinary skill in the art to modify Cocotis for identification information within an information pattern such as a barcode as taught by Miller. One of ordinary skill in the art would have been motivated to employ the teachings of Miller in order to enable the capability to access a wealth of information concerning an entity from a single piece of information, the barcode. (Miller para 006, ll 1-5; para 006, ll 9-13; para 007, ll 11-15)

And, Parry discloses:

information concerning a printing condition. (Parry col 1, ll 62-67: translated barcode includes information on printing the document (printing condition); col 2, ll 3-7: translation comprises translating the barcode to obtain at least one identifier that designates the type of contents in the document)

It would have been obvious to one of ordinary skill in the art to modify Cocotis-Miller for information concerning a printing condition as taught by Parry. One of ordinary skill in the art would have been motivated to employ the teachings of Parry in order to enable an error free transmission of a document to a printer or other device such as a fax machine or copier simply by sending an email with one or more barcodes embedded therein. (Parry col 7, ll 29-32: " *... Accordingly, an error free transmission of a document to a printer or other device such as a fax machine or copier, can be accomplished simply by sending an email with one or more barcodes embedded therein. ...* ")

Cocotis does not explicitly disclose a printing condition unit including *at least one of* a sheet size, a printing quantity, a black and white/color printing selection, a reduction ratio and a quantity of pages N,
the quantity of pages N corresponding to the number of pages to be placed on a single page in N-up printing.

However, Shea discloses:

a printing condition unit (Shea col 4, ll 39-42: printstream is sent from printstream processor to a printer; col 2, l 65 - col 5, l 2: sent to message router for delivery to specified delivery mechanism, e.g. a printer; col 6, ll 52-58: document data may include information identifying data fields and instruction to a printer) including a quantity of pages N; (Shea col 7, ll 24-30: bar code may include page total indicating how many pages; col 7, ll 58-67: parser may consult a total page count (quantity of pages N) as stored in a barcode code; barcode indicates that a currently document contains "n" documents)

It would have been obvious to one of ordinary skill in the art to modify Cocotis-Miller-Parry to enable a printing condition unit including a quantity of pages N as taught by Shea. One of ordinary skill in the art would have been motivated to employ the teachings of Shea in order to utilize bar code data within an electronic printstream to assist in identifying and formatting printstream data for electronic presentment such as printing. (Shea col 1, ll 9-12)

And, Wong discloses specific printing conditions wherein:
a black and white/color printing selection, and a reduction ratio. (Wong col 3, ll 41-47: optics for such a printer must provide telecentric illumination for color printing applications employing LCD modulators; col 12, ll 2-6: alternative embodiment of printer; dithering pattern for a LCD modulator is shown; col 4, ll 53-58: using different reduction ratios; arrangements at lower reduction ratios; arrangements at higher reduction ratios; commonly agreed upon by COM (printing systems) equipment and manufacturers; col 16, ll 60-66: barcode or other optical encoding; barcode reader)

It would have been obvious to one of ordinary skill in the art to modify Cocotis-Miller-Parry-Shea for a black and white/color printing selection or a reduction ratio as taught by Wong. One of ordinary skill in the art would have been motivated to employ the teachings of Wong in order for an improved printing apparatus that is inexpensive, compact, and robust, and that allows printing in any of a plurality of output media formats. (Wong col 6, ll 1-5)

## *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung Hye Shin whose telephone number is (571)272-3920. The examiner can normally be reached on 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia L. Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyung Hye Shin
Examiner
Art Unit 2443

January 2, 2009

/Kyung Hye Shin/
Examiner, Art Unit 2443